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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,409	06/15/2001	Hironori Kobayashi	DAIN:498A	8853

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EXAMINER

MCPHERSON, JOHN A

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 08/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/882,409

Applicant(s)

KOBAYASHI ET AL.

Examiner

John A. McPherson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 82-216 is/are pending in the application.

4a) Of the above claim(s) 83-95, 97-103, 106-113, 116-146, 150-153 and 155-216 is/are withdrawn from consideration.

- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 82, 96, 104, 105, 114, 115, 147-149 and 154 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of the color filter of claim 149 as the ultimate species in Paper No. 6 is acknowledged.

Claims 82, 96, 104, 105, 114, 115, 147 and 148 are generic to the elected species, so these claims have been included in the initial examination with the elected species. Additionally, claim 154 has been included with the initial examination because it depends from elected species claim 149.

Claims 83-95, 97-103, 106-113, 116-146, 150-153 and 155-216 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 82, 96, 104, 105, 114, 115, 147-149 and 154 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6,450,635. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed invention, which is not limited to any specified means of providing a plurality of colors, is inclusive of the patented invention, which requires providing the plurality of colors with an ink jet system. Furthermore, ink jet printing is a well-known method of applying colorants to selected portions of a substrate to fabricated articles, such as color filters. Accordingly, allowing the present application to issue would result in a second patent which is not patentably distinct from the first patent.

3. Claims 82, 96, 104, 105, 114, 115, 147-149 and 154 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of copending Application No. 10/142,379, published as U.S. Patent Application Publication 2002/0126194. Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed invention, which is not limited to any specified means of providing a plurality of colors, is inclusive of the copending invention, which requires providing the plurality of colors with an ink jet system. Furthermore, ink jet printing is a well-known method of applying colorants to selected portions of a substrate to fabricated articles, such as color filters. Accordingly, allowing the present application and the copending application

to issue would result in a two patents including the same invention within the scope of their claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 104 and 114 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 9-260808 (JP '808). JP '808 discloses a method of forming metal wiring by photocatalytic reaction comprising the steps of forming a substrate comprising a photocatalyst on the surface of a base board, immersing the board in a metal ion-containing water solution, forming a pattern on the board utilizing a laser beam, and immersing the board in a water solution to remove adsorbed metal ions, thus forming a patterned metal film. See the abstract and Figure 1.

5. Claims 104 and 114 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 9-131914 (JP '914). JP '914 discloses a method of forming an ink image comprising the steps of providing a hydrophilic TiO<sub>2</sub> photocatalyst layer on an ink image carrier,

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coating the whole surface of the hydrophilic carrier body with a water repellent substance, selectively resolving the water repellent substance in a pattern by irradiation of light, and supplying an aqueous ink to the surface of the exposed hydrophilic image carrier body. See the abstract, and Figures 1 and 3.

6. Claim 147 is rejected under 35 U.S.C. 102(b) as being anticipated by EP 0 725 315 (EP '315). EP '315 discloses a method of forming a color filter comprising the steps of applying a photosensitive resin composition on a substrate, wherein the photosensitive resin composition comprises polysilane, a combination of a photoradical generator and an oxidizing agent, and a specified silicon oil compound; selectively exposing the photosensitive layer to light to form a latent image by breaking Si-Si bonds of the polysilane to form Si-OH groups (i.e. wettable hydrophilic portions); and coloring the exposed areas with a solution containing a dye or pigment. See page 2, line 34 to page 3, line 4 and page 5, line 56 to page 6, line 10.

7. Claims 82, 96, 104, 105, 114 and 115 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 1 329 589 [listed on the Information Disclosure Statement filed 10/10/01] (GB '589). GB '589 discloses hydrophilic-hydrophobic photo sensitive medium comprising a radiation sensitive material such as oxides of zinc, titanium and tin (corresponding to the photocatalyst of the present invention) and a hydrophobicity inducing agent such as polydimethylsiloxane, wherein the image is such that it is

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hydrophobic when unexposed and hydrophobic when exposed. See page 1, lines 11-16; page 3, lines 37-39; and page 3, lines 46-52.

8. Claim 147 is rejected under 35 U.S.C. 102(b) as being anticipated by JP 9-033910 [abstract only listed on the Information Disclosure Statement filed 10/10/01, the entire document with a computer-generated translation is provided with this Office Action] (JP '910). JP '910 discloses a process for the manufacture of a color filter comprising exposing some parts of a coloring acceptance layer formed on the surface of a glass substrate, whereby the exposed parts are hydrophilic and other parts are water-repellent, and selectively coloring the exposed parts.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. McPherson whose telephone number is (703) 308-2302. The examiner can normally be reached on Monday through Friday, 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on (703) 308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



John A. McPherson  
Primary Examiner  
Art Unit 1756

JAM  
July 30, 2003